

REMARKS

Reconsideration of this application is respectfully requested. Applicant has addressed every ground for rejection in the Office Action dated September 25, 2003, and believes the application is now in condition for allowance. Applicant's attorney would like to thank the Examiner for speaking with him on September 19, September 22 and October 10, 2003. Written statements summarizing the brief discussions held with the Examiner are enclosed herewith.

The present invention generally relates to a system for organizing Internet information based on discrete geographic and topical categories, and more particularly to a substantially automated system for organizing Internet information based on discrete geographic and topical categories which permits users to obtain information regarding businesses or merchants from a particular geographic area who place information on the system. Moreover, merchants may access the system to input and post information about the merchant's business into one or more of the geographic areas and topical categories using a substantially automated process. Allowing the merchants to list themselves on the system thereby simplifies the process and reduces the overall cost of advertising for the merchants. The present invention further relates to a system that permits merchants to conduct commercial transactions with users or shoppers using the system. Information that may be listed by the merchants includes, but is not limited to, advertising, coupons, business listings and job opportunities. Revenue may be generated through use of the system through, among other things, the listing of the merchant information in the geographic areas and topical categories and advertising. The system also permits consumers to buy and/or sell items based on a particular geographic area or areas.

The claims have been amended to more clearly describe the present invention. Specifically, Claim 1 has been amended to clarify that creation and posting of business listings and advertising is done through a substantially automated process, and that the system includes means for generating revenue. Claim 9 has been amended to clarify that the system is directed to any type of geographic location and is not limited to listing in towns. Claim 46 has been amended to clarify that the system comprises one or more Internet web pages and to include the limitations of means for monitoring usage of the system, means for providing statistics regarding the usage and means for generating revenue. Claim 64 has been amended to clarify that the website comprises one or more Internet web pages and to include steps of monitoring usage of the system, providing statistics regarding the usage and generating revenue. Claims 2, 5, 7, 10, 12, 58, 60, 61 and 69 have been amended to correct typographical or grammatical errors or to otherwise clarify the claims, and were not amended in view of a rejection by the Examiner. Finally, previously withdrawn claims 16 through 45, and claims 50, 51, 65 and 66 have been cancelled; and Claims 76 through 89 have been added.

Claims 1-8 and 46-75 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rosen et al U.S. Patent No. 6,118,449 and Hanson et al U.S. Patent No. 5,974,398. Rosen discloses a system for modifying a cursor image for advertising purposes. The cursor image corresponds to the content received by the user terminal. Hanson is directed to a system whereby companies direct advertisements to consumers based on their demographic information. Customer image profiles and service usage data are collected and used to allow business to “bid” on the amount of money that they will pay to have the consumer view the business’ advertisement. The system reviews and

organizes the bids submitted by the companies and only provides the top "bidders" to the consumer to allow the consumer to choose which bids to view.

In order to establish a *prima facie* case of obviousness, the examiner must show that there is "[1] some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. . . . [2] a reasonable expectation of success." and [3] a prior art reference or references that teach or suggest all of the claimed limitations. M.P.E.P. § 706.02(j).

In determining whether a claim is obvious over the prior art, the patent statute (35 U.S.C. § 103), the Supreme Court and the Circuit Court of Appeals for the Federal Circuit all require consideration of the subject matter of the structure of the "invention as a whole" and the problem it solves as viewed in the light of the prior art teachings at the time of the invention. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150, 9 U.S.P.Q.2d 1847, 1851-52 (1989); *In re Ochiai*, 71 F.3d 1565, 1569, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1995). When determining whether the claimed subject matter is obvious, it is well established law that

[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the reference.

M.P.E.P. § 706.02(j) (*quoting Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int.1985)).

The obviousness analysis focuses on the differences or changes between the claimed subject matter of the application and the subject matter contained within the prior

art references at the time of the invention. Regardless of the simplicity of the changes, the claimed subject matter will be patentable if the prior art fails to teach, suggest or motivate one of ordinary skill in the art to modify what was known in the prior art, including any personal knowledge, to obtain the claimed subject matter. In particular, the Federal Circuit has stressed that

[i]n a proper obviousness determination, '[w]hether the changes from the prior art are 'minor,' . . . the changes must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the patentee's device.' This includes what could be characterized as simple changes . . .

In re Chu, 36 U.S.P.Q.2d 1089, 1094 (Fed. Cir. 1995) (citations omitted).

Especially in the case where the claimed subject matter relates to simple changes or simple devices, it is of supreme importance to avoid the use of hindsight. The courts, including the United States Court of Appeals for the Federal Circuit, have steadfastly condemned hindsight application of prior art to find an invention *prima facie* obvious:

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Al-Site Corp. v. VSI Int'l, Inc., 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) (*citing W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed.Cir.1983)).

The standard of obviousness is not whether in hindsight, it seems elementary that someone would have combined these certain elements in the prior art to form the invention in question. *See e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, [220 USPQ 303, 313] (Fed. Cir. 1983). Hindsight is almost always perfect. It is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention. *Winner Int'l Royalty Corp. v. Wang*, 48 U.S.P.Q.2d 1139, 1144 (D.C. D.C. 1998)

In view of this important principal, a "particular finding must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *In re Werner Kotzab*, Case. No. 99-1231 (Fed. Cir. June 30, 2000). "Broad conclusory statements standing alone are not 'evidence.'" *Id.* (*citing In re Dembicza*k, 175 F.3d 994, 999, 50 U.S.P.Q. 1614, 1617 (Fed. Cir. 1999)). In determining *prima facie* obviousness in the Final Rejection of Claims 1 to 8 and 46-75, it is submitted that the Examiner has violated the teaching or suggestion test and resorted to hindsight. As explained in more detail below, the obviousness rejection should therefore be reversed and the claims should be allowed to issue.

It is submitted that the Examiner's rejection over Rosen in view of Hanson does not constitute a *prima facie* case of obviousness as required under 35 U.S.C. §103 in rejecting claims. In order to establish a *prima facie* case of obviousness, the Examiner must establish that a prior art reference or references teach or suggest all of the claimed limitations; there is some suggestion or motivation to modify the prior art to obtain the claimed invention; and there is a reasonable expectation of success. M.P.E.P. §706.02(j).

As indicated above, and for reasons described in more detail below, it is believed that Claims 1, 46 and 64, and all claims depending therefrom, are allowable over Rosen and Hanson because neither reference, nor any of the other prior art references of record, teaches or suggests each and every limitation in the claims. In particular, both references fail to teach with respect to Claim 1, among other things, means for the *substantially automated* creation and posting of business listings and/or advertising by users of the system, and means for *substantially automated* selection by said merchants of the

categories and geographic locations in which to display the advertising and business listings. Similarly, with respect to claims 46 and 64, the prior art references of record do not teach, among other things, a system or method that allows merchants to input information onto an Internet web page using a *substantially automated* process.

As defined by Webster's dictionary, the word "automated" means "to convert largely to automatic operation" or to "operate by automation," wherein "automation" is defined as "the technique of making an apparatus, a process or a system operate automatically" or "automatically controlled operation of an apparatus, process or system by mechanical or electronic devices that take the place of human organs of observation, effort and decision." Accordingly, unlike the prior art, the present invention does not require the information to be reviewed and/or inputted by a human being associated with the system operator or third party prior to the information being posted onto the web page into selected geographic areas and topical categories.

It is respectfully submitted that neither Rosen nor Hanson teach a substantially automated process for merchants to input information such as business listings for display in selected geographic areas and topical categories. Contrary to Examiner's findings, Rosen does not teach a web system that allows users to advertise business listings. Rather, Rosen merely teaches the use of cursor images, which may be used to reinforce banner advertising. A Cursor Display Code may be retrieved from a remote server to modify the cursor image. There is absolutely no teaching of allowing a merchant or other user to input information onto a web page using a substantially automated process.

Furthermore, there is absolutely no teaching or suggestion that a merchant may select particular geographic locations and categories in which to list its business listing to

enable the geographic targeting of consumers by the merchants. In citing the Rosen reference, the Examiner has focused on the phrase “Travel & Regional” shown in Fig. 8; however, the web page shown in Fig. 8 is merely an example of a web page that uses a modified cursor (44a) as taught by the patent. There is absolutely no disclosure in the patent regarding what information is located under that apparent hyperlink or how, if at all, information is inputted into any web pages. It is respectfully submitted that the paragraph from Rosen cited by the Examiner as teaching that users may select business listings and advertising merely relates to browsers in general and does not teach that business listing and advertising may be selected by users through the browser.

Accordingly, Rosen, unlike the present invention, does not teach a system or method wherein merchants or other entities may list their business information for display according to a hierarchy of geographic areas and topical categories, whereby a consumer may select a particular geographic area and topical category in order to view the business information that was created by the merchants. As indicated above, there is no disclosure or teachings that Fig. 8 in Rosen comprises a web page(s) that lists information in geographic areas and topical categories. Instead, Fig. 8 from Rosen is likely related to web page that utilizes a search engine that may be used to search the web for information. As explained in the patent application, the use of search engines has several problems, including the fact that the quality of the search becomes dependent on the metatags and/or keywords employed by the merchants’ web pages, and a search often will result in too many results. As a result, a search engine will likely include results that do not match up with the user’s request and/or will not include listings that would match up with the user’s request. The present invention solves these problems by allowing the

merchant to place its information on the system according to selected geographic locations and categories. Rather than have the system search for information from web pages in an attempt to find matches, the present system will list the information provided by the merchants by geographic location and categories. Accordingly, the present invention will allow the users to find business information that is specifically related to the geographic locations and categories that they select.

Additionally, Hanson does not teach a system or method that allows merchants to list business listings, advertising and other information on the basis of geographic locations and topical categories, whereby users may select a particular geographic location and then a topic or category to find a particular listing or advertisement. Rather, the system teaches the use of demographic databases to provide information to advertisers. The advertisers then elect whether they want to offer advertisements to the users. Such a form of advertising is highly inefficient because it sends advertisements to many consumers who have no interest in the products or services, thereby, among other things, possibly upsetting consumers, and it also does not include other consumers, based solely on their demographic information, who may be interested in the products or services. Furthermore, incorrectly entered information by the consumers will likely lead to the advertisers overlooking those consumers. The system also does not take into consideration the travel of consumers as the only geographic information that may be contained in the database are the consumers' hometowns. Thus, unlike the present invention, under the teaching of Hanson, consumers will not be able to view or receive advertising information pertaining to business in the towns in which they may be visiting. It is respectfully submitted that by stating that the claimed limitations would be obvious

to one or ordinary skill in the art, the Examiner has resorted to hindsight in view of Applicant's own invention. As Rosen and Hanson, individually or in combination, fail to teach each and every limitation of Claims 1, 46 and 64, it is respectfully submitted that Claims 1, 46 and 64, and those claims depending therefrom, are patentably distinct over Rosen and Hanson.

It is respectfully submitted that there is no teaching, suggestion or incentive to combine Rosen with Hanson. When determining whether a claim is obvious in view of the prior art, "it is insufficient if prior art shows similar components unless it also contains some teaching, suggestion or incentive for arriving at the claimed structure." C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1351 (Fed. Cir. 1998) citing Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 935, 15 USPQ.2d 1321, 323 (Fed. Cir. 1990). Rather, "the prior art must suggest to one of ordinary skill in the art the desirability of the claimed invention." Id. at 1352, citing Fromsom v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985).

With respect to the claimed invention, a primary goal is to allow merchants and other users enter their information into one or more geographic locations and topical categories through a substantially automated system, wherein users can access the information by the specific geographic locations and topical categories. Contrary to this feature, the system in Hansen uses demographic information in order to target a group of people based on particular characteristics. Accordingly, one of ordinary skill in the art, looking to provide a system that allows a user to view merchant information based on user-selected geographic locations and topical categories would not look to a system that strictly uses demographic information. Furthermore, even if the prior art references were

to teach what the Examiner is proposing, because of the problems associated with allowing merchants and other users to input their information without human interaction and review [see Deeds decl. par. 8], it is submitted that one of ordinary skill in the art would not be motivated to combine the references to provide a system that provides for the substantially automated creation and posting of merchant information. This point is reinforced by the fact that none of the prior art references teach a system or method that allows for the substantially automated creation and posting of merchant information into one or more geographic and topical categories.

For all of the aforementioned reasons, it is respectfully submitted that the Examiner has not met the requisite standard in establishing obviousness. As there is absolutely no teaching or suggestion in the prior art to provide a system or method that, among other things, allows for the substantially automated creation and posting of merchant information into one or more geographic areas and topical categories, it is respectfully submitted that Claims 1, 46 and 64, and claims dependent therefrom, of the present invention are patentably distinct over the prior art of record and should be allowed.

In order to further demonstrate the patentability and non-obviousness of the subject matter of the pending claims, the declaration of Robert G. Deeds Jr., one of the inventors of the present application, is submitted herewith. Mr. Deeds, who has been working with and on computers for more than twenty-five (25) years and is intimately familiar with the field of the present invention, stated that he was not aware of any other individual or entity who offered an online interactive web site information system that, among other things, displayed information and advertising in certain selected geographic

locations and topical categories, and provided for the substantially automated creation and posting of the information and advertising. [Deeds decl. par. 2, 5 and 6]. In fact, as set forth by Mr. Deeds, the conventional wisdom at the time of the invention, and even today, was to have users submit the information and advertising to employees or agents of the system's operators, who thereafter reviewed the material, corresponded with the entity or person who submitted the information, and inputted and posted the information into the system. [Id. at par. 7]. Otherwise, the system operator had no control over what information was posted to the system. [Id.]. Accordingly, it is respectfully submitted that one of ordinary skill in the art would not consider it obvious to allow the substantially automated inputting and posting of information by others onto a web site.

Claims 9 through 15 have been deemed allowable by the Examiner. As Claims 10 and 12-15 do not depend from Claim 9, Claims 76 through 79, which include the limitations of Claims 10 and 12-14 and depend from Claim 9 have been added herewith. It is respectfully submitted that these claims are therefore allowable.

Finally, to more clearly define the unique features of the present invention, new Claim 80 has been added. Applicant respectfully submits that new Claim 80 is distinct from all of the references of record. In particular, each of the references of record fails to teach or suggest, among other things, an interactive web site that allows merchants to input their information into geographic areas and topical categories that they specifically choose, which, in turn, allows consumers to access the merchant information by selecting from the plurality of geographic areas and topical categories listed on the series of Internet web pages. The present invention thus overcomes the problems present in search engines through, among other things, the elimination of the reliance on metatags and

keywords, and by allowing merchants to specifically direct their advertising and other information to specific geographic areas. As discussed in the telephone conference between Applicant's attorney and the Examiner, the Examiner stated that the inclusion of coupons as a means for generating revenue, may be enough to overcome his rejection of the pending claims in view of the prior art. Therefore, because all of the above references of record, either alone or in combination, fail to teach or suggest Applicant's invention as claimed in new Claim 80, Applicant respectfully submits that the new claim is patentably distinct over the prior art of record. Allowance of the new claim is therefore respectfully requested.

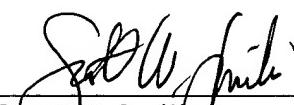
Claims 81 to 83 have also been added to provide that the geographic areas and topical information are provided on the web page in the form of drill-down menus. Claims 84 to 86 have been added to state that the creation and posting of the information onto the web page(s) occurs in real time. Claims 87 to 89 have been added to provide that the information comprises business listings. It is respectfully submitted that none of the prior art or record teaches these limitations and these claims should be allowed.

Applicant submits that in view of the above-identified amendments, supporting remarks and declaration of Robert G. Deeds Jr., the claims in their present form are patentably distinct over the cited prior art. Allowance of the claims is respectfully requested.

Should the Examiner discover that there are remaining issues that could be resolved by an interview, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

March 25, 2004
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